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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/677,663	10/02/2000	William E. LeBoeuf	J-2961	3408

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 09/11/2002

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/677,663

Applicant(s)

LEBOEUF ET AL.

Examiner

Alicia Chevalier

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-100 is/are pending in the application.
- 4a) Of the above claim(s) 51-79 and 96-100 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-50 and 80-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5,6,7, 9,10,11,12,13,15,16,18
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-50 and 80-95 in Paper No. 17 is acknowledged.

Claim Objections

2. Claim 80 is objected to because of the following informalities: misspelling of liquid in line 6, "iquid". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5, 13, 17, 24, 30, 38, 42, 50, 83 and 91-93 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "ABS" in claims 5, 13, 17, 24, 30, 38, 42, 50, 83 and 91 is unclear and renders the claims vague and indefinite. It is unclear what is abbreviated by ABS, i.e. alkyl benzene sulfonate, acrylonitrile-butadiene-styrene copolymer, antilock brake system, etc.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-5 and 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Kessler (4,116,426).

Kessler discloses a cutting board comprising a transparent plastic comprising acrylic plastic or polystyrene (col. 3, lines 41-50). The cutting board has an embossed cutting surface (discontinuous pattern of material).

It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. *It re Hutchison*, 69 USPQ 138. Therefore all the claims that further limit the sheet, the liquid impervious barrier, and the liquid absorbent portion in claim 1 are not given weight since they merely further limit a non positive limitation.

Art Unit: 1772

7. Claims 1-3 and 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyake et al. (5,085,416).

Miyake discloses a cutting board made of an organic polymer such as polyvinyl chloride, polyethylene, polypropylene, etc. (col. 3, lines 51 to col. 4, line 2).

It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. *It re Hutchison*, 69 USPQ 138. Therefore all the claims that further limit the sheet, the liquid impervious barrier, and the liquid absorbent portion in claim 1 are not given weight since they merely further limit an non positive limitation.

8. Claims 80-83 and 86-87 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson (3,929,135).

Thompson discloses an absorptive device comprising a topsheet with a plurality of holes, an absorbent core, and a backsheet. The topsheet and backsheet are made of polyethylene and the absorbent core is made of creped cellulose wadding. See column 3, lines 19-42, column 6, lines 11-30, and figure 1.

9. Claims 1-5, 9-13, 25-30, 34-42, and 46-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Vargo (4,328,275).

Vargo discloses a disposable floor mat comprising a top layer of discontinuous silicone-polyester, which is relatively rigid and substantially incompressible, an absorbent core of cellulosic fibrous material, and a liquid impervious layer made of polyethylene or polyester (col. 2, lines 17-52).

Art Unit: 1772

It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. *It re Hutchison*, 69 USPQ 138. Therefore all the claims that further limit the sheet, the liquid impervious barrier, and the liquid absorbent portion in claim 1 are not given weight since they merely further limit an non positive limitation.

10. Claims 1-4, 6, 9-16, 20-23, 25-29, 31, 34-37, 39-41, 43, 46-49, 80-82, 86-90, 94, and 95 are rejected under 35 U.S.C. 102(b) as being anticipated by Alston et al. (5,270,089).

Alston discloses a fluid absorbing system comprising a first layer of a grid of inverted cones with drain holes or openings, a fluid absorbing mat, and a liquid impervious bottom layer (figure 2). The absorbing mat comprises cellulose fiber (col. 3, lines 64-66).

It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. *It re Hutchison*, 69 USPQ 138. Therefore all the claims that further limit the sheet, the liquid impervious barrier, and the liquid absorbent portion in claim 1 are not given weight since they merely further limit an non positive limitation.

11. Claims 1-4, 6, 9-16, 20-29, 31, 34-41, 43, 46-50, 80-82, 86-90, 94, and 95 are rejected under 35 U.S.C. 102(b) as being anticipated by Shigeru (10137140).

Shigeru discloses a handy paper chopping block comprising an upper layer of coated paper with holes, a pulp fiber absorbing center, and a polypropylene backing (European Abstract).

It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. *It re Hutchison*, 69 USPQ

Art Unit: 1772

138. Therefore all the claims that further limit the sheet, the liquid impervious barrier, and the liquid absorbent portion in claim 1 are not given weight since they merely further limit an non positive limitation.

12. Claims 1-50 and 80-95 are rejected under 35 U.S.C. 102(e) as being anticipated by Otten et al. (6,274,232 B1).

Otten discloses an absorbent sheet material comprising a cut resistant layer with a plurality of holes, an absorbent layer, and a backing liquid impervious layer (figure 6). The cut resistant layer may comprise such polymers as EVA, polyethylene, polystyrene, PVC, PET, polypropylene, etc. (col. 4, lines 12-21). The backing layer may be made of such polymers as EVA, polyethylene, etc. (col. 6, line 65 to col. 7, line 4). The absorbent layer can be made of cellulosic fibers (col. 3, lines 44-49).

It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. *It re Hutchison*, 69 USPQ

138. Therefore all the claims that further limit the sheet, the liquid impervious barrier, and the liquid absorbent portion in claim 1 are not given weight since they merely further limit an non positive limitation.

13. Claims 1-5, 9-13, 25-30, 34-37, 39-42 and 46-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Carson et al. (6,383,614 B1).

Carson discloses a multi-purpose sheet material comprising a dissentional layer of cut resistant material, an fluid absorbing layer, and a liquid impervious backing (figure 3). The fluid absorbing layer may comprise cellulosic fibers or paperboard (col. 4, lines 57-67). The backing layer maybe made of an suitable polymeric film (col. 5, lines 7-17). The cut-resistant material

Art Unit: 1772

may comprise any suitable polymeric material such as EVA, polyethylene, PVC, polypropylene, PET, etc. (col. 7, lines 8-22).

It has been held that the recitation that an element is “capable of” performing a function is not a positive limitation but only requires the ability to so perform. *It re Hutchison*, 69 USPQ 138. Therefore all the claims that further limit the sheet, the liquid impervious barrier, and the liquid absorbent portion in claim 1 are not given weight since they merely further limit an non positive limitation.

Claim Rejections - 35 USC § 102/103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 84 and 85 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Thompson (3,929,135).

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA

Art Unit: 1772

1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation holes formed by punching or perforating is a method of production and therefore does not determine the patentability of the product itself.

16. Claims 7, 8, 18, 19, 32, 33, 44, 45, 84, 85, 92 and 93 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Alston et al. (5,270,089).

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-

Art Unit: 1772

process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation holes formed by punching or perforating is a method of production and therefore does not determine the patentability of the product itself.

17. Claims 7, 8, 18, 19, 32, 33, 44, 45, 84, 85, 92 and 93 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shigeru (10137140).

The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation holes formed by punching or

Art Unit: 1772

perforating is a method of production and therefore does not determine the patentability of the product itself.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139.

The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays


If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

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9/7/02

AC


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

9/8/02